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09/501,408	02/10/2000	Frederic Serre	A32979-070337.0181	3806
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EXAMINER				
RONESL, VICKEY M				
ART UNIT		PAPER NUMBER		
1796				
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03/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary**Application No.**

09/501,408

Applicant(s)

SERRE, FREDERIC

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 12/3/2007.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 12/3/2007. In particular, claim 23 has been amended to recite new amounts of carbon black and silica. Thus, the following action is properly made final.

Claim Objections

4. Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Instant claim 35 recites 20-45 phr which has a lower lower limit than in independent claim 23 which recites 25-50 phr.

Claim Rejections - 35 USC § 112

5. Claims 23-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 23, the amended combined amount of carbon black and silica fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase 25-50 phr of carbon black and silica wherein the amount of silica is not greater than or equal to the amount of carbon black in phr minus 5 phr in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. While there is support for a combined amount of 15-50 phr when the amount of silica is not greater than or equal to the amount of carbon black in phr minus 5 phr on page 4, lines 1-4 of the specification, there is no support for the combined amount of 25-50 phr with no condition on the amount of silica with minus 5 phr. Case law holds that, with respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

With respect to claims 24-42, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

6. Claims 29-32 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom et al (US 5,394,919) in view of JP '146 (JP 09-302146).

The rejection is adequately set forth in paragraph 7 of Office action mailed on 7/2/2007 and incorporated here by reference.

7. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom et al (US 5,394,919) in view of JP '146 (JP 09-302146) and further in view of Takeichi et al. (U.S. 6,008,295).

The rejection is adequately set forth in paragraph 8 of Office action mailed on 7/2/2007 and incorporated here by reference.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom et al (US 5,394,919) in view of JP '146 (JP 09-302146) and further in view of Fukahori et al. (U.S. 5,844,050).

The rejection is adequately set forth in paragraph 9 of Office action mailed on 7/2/2007 and incorporated here by reference.

9. Claims 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom et al (US 5,394,919) in view of JP '146 (JP 09-302146) and further in view of Vanel (U.S. 6,211,278).

The rejection is adequately set forth in paragraph 10 of Office action mailed on 7/2/2007 and incorporated here by reference.

10. Claims 23-25, 29-31, 35, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta et al (U.S. 6,776,206) in view of JP '146 (JP 09-302146).

The rejection is adequately set forth in paragraph 11 of the office action mailed 2/27/06 and is incorporated here by reference.

11. Claims 26-27 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta et al (U.S. 6,776,206) in view of JP '146 (JP 09-302146) and further in view of Takeichi et al. (U.S. 6,008,295).

The rejection is adequately set forth in paragraph 12 of the office action mailed 2/27/06 and is incorporated here by reference.

12. Claims 26, 28, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta et al (U.S. 6,776,206) in view of JP '146 (JP 09-302146) and further in view of Fukahori et al. (U.S. 5,844,050).

The rejection is adequately set forth in paragraph 13 of the office action mailed 2/27/06 and is incorporated here by reference.

13. Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta et al (U.S. 6,776,206) in view of JP '146 (JP 09-302146) further in view of Vanel (U.S. 6,211,278).

The rejection is adequately set forth in paragraph 14 of the office action mailed 2/27/06 and is incorporated here by reference.

14. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segatta et al. (U.S. 6,776,206) in view of JP '146 (JP 09-302146).

The rejection is adequately set forth in paragraph 9 of the office action mailed 10/19/2006 and is incorporated here by reference.

Response to Arguments

15. Applicant's arguments filed 12/3/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Sandstrom et al teaches that its composition is used in the tire crown and not in the bottom zone like presently claimed; (B) that Sandstrom et al does not teach precipitated or pyrogenic silica; (C) that instant claim 29 does not contain carbon black; (D) that Segatta et al does not disclose or suggest the relative amounts of silica and carbon black like presently claimed; (E) that JP '146 discloses amounts of carbon black and silica that do not fall within the presently claimed ranges; and (F) that Segatta et al does not teach precipitated silica.

With respect to argument (A), Sandstrom et al discloses that its laminate is used in a tire as a steel belt, steel bead, or wire carcass (col. 2; lines 52-58) and is not limited to the tire crown. While the claims are drawn to a tire crown, such does not limit the disclosure of Sandstrom et al to just tire crowns.

With respect to argument (B), Sandstrom et al discloses in col. 4, lines 46-50 that pyrogenic or precipitated silica can be used.

With respect to argument (C), instant claim 29 recites open claim language "comprising" is therefore open to the use of carbon black. Carbon black is not explicitly excluded from the claim language.

With respect to argument (D), Segatta et al discloses the use of 20-200 phr carbon black and 5-25 phr precipitated silica, wherein when the amount of silica is 25 phr and the amount of carbon black is 20 phr, the total amount of carbon black and silica is 45 phr and falls within the presently claimed amounts. While Segatta et al teaches that silica is optional, it is perfectly

proper for the examiner to look to the whole reference for what it teaches rather than merely rely on preferred embodiments. *In re Courtright* 153 USPQ 735 (CCPA 1967).

With respect to argument (E), while JP '146 does not disclose all the features of the present claimed invention, it is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention.

With respect to argument (F), Segatta et al teaches the use of amorphous hydrated silica which is the same as precipitated silica.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/27/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/
Supervisory Patent Examiner, Art Unit 1796